

## REMARKS

Receipt of the Action of September 28, 2007 is acknowledged. While various changes have been made to some of the claims to make them more precise, or to broaden them, it is respectfully submitted that none of the references applied in the Action are even remotely similar to the claimed invention, and do not relate to its purposes, functions, and results.

The invention relates to methods of producing artwork using a computer controlled printer. The artwork is prepared first by manipulating an image in the computer to control color, and then printing out the image onto a substrate, and then subsequently acting on the printed substrate. The Ishizuka, Jam et al, and Kohno patents have no relationship to these methods whatsoever.

Ishizuka relates to an image processing device, and more specifically, relates to an image processing device having various image edit functions. The Ishizuka device is one which can completely finish setting of edit functions before starting image processing, which can reduce the number of copy errors and improve the work efficiency, and which can suppress a cost increase due to adding a memory or the like to the apparatus itself. The image processing device according to Ishizuka comprises an image processing unit which takes in a document image as digital information and processes and edits the data, an operation unit which combines and sets a plurality of image edit functions with respect to the document image, a bitmap data memory which stores a plurality of edit images, and a display unit which reads out the picture image set by combining the image edit functions from the bitmap memory and displays the image, before outputting the image processing result. Ishizuka in no way acts on the substrate on which the image is applied after application.

The Jam et al reference (“Jam”) also does not even remotely relate to the claimed invention. Jam deals with the problem of editing a digital image that has previously been saved in a lossy manner (whether such losses result from the editing operations and/or from inherently lossy image file formats such as JPEG), where typically each additional editing session typically compounds the overall losses. Jam solves this problem by creating and storing a proxy for an edited image, the proxy including a baseline image

and a series of meta data representing editing operations performed on that image. During a subsequent editing session, the edited image can be partially or wholly reconstructed by applying the meta data to the baseline image, resulting in a comparatively lossless version thereof. The reconstructed image can be used as a starting point for additional edits, thereby minimizing the compound losses that would otherwise have resulted. After this, the final step in Jam is at 470 in Figure 4:

"after the user has revised the picture to his satisfaction (including possibly by doing nothing), the image can be written to any form of computer-readable medium. As in steps 130 150 of FIG. 1, the image can be saved in any desired form. For example, if the user believes no more edits (or reviews) will be performed, he can direct the program to save the image in the conventional manner (i.e., without meta data) only. Or, if the user knows he will later continue to edit (or review) his work, he can direct the program to save the image in proxy form (i.e., baseline image plus meta data) only. Or, the program could store both." [col. 8, lines 50-60].

Jam does not even mention "printing" (except in discussing the unacceptable prior art, col. 2, lines 38-42), or acting on a substrate. Any "acting on" the image is in the computer.

Kohno merely discloses the general concept of an ink jet printer. In the inkjet printer of Kohno, which has primary power-turn-on means for physically supplying power to the printer and secondary power-turn-on means for bringing the printer into a state where functions are enabled, ink consumption due to a suction recovery processing is reduced. The number of times that the secondary power supply is on is counted. The count value is stored in a non-volatile memory. It is judged whether the count value is above a predetermined value when the secondary power supply becomes on, if yes, the recovery processing is executed. The count value and the contents of the memory are then cleared. The counting is prohibited till primary power supply is off. As the above contents is retained even after the primary power supply is off, necessity of recovery processing when the secondary power supply becomes on is judged based on the state before the primary power supply was off. Kohno has no relevance to the invention except that it shows that ink jet printers with cartridges exist, something of course clearly admitted in applicant's specification since it is a new use of such a printer that one aspect of the invention contemplates.

In summary, while according to each of independent claims 1, 20, and 24 some action is performed on an image on a substrate (what Kohno calls a “printing medium”) after printing, in order to produce a piece of art, none of the references contemplate acting on the substrate after application of an image. Ishizuka is interested only in producing good copies with a copying machine, not acting on the copies once produced. Jam does not really care even about printing its images out, it merely wants to store high quality images. In Kohno, the final step is printing on the substrate (printing medium), no further action being contemplated.

Thus, none of claims 1, 20 or 24 can possibly be considered anticipated by or obvious over any of Ishizuka, Jam, and Kohno. Not only do they not teach this feature of the claimed methods, there is absolutely no basis whatsoever by which one of ordinary skill in the art would seek to modify them to provide the invention. The references do not deal with the same proximate problem as the invention (see *In re Pye*, 148 USPQ 426, 429 (CCPA 1966)), do not achieve the advantages of producing distinctive works of art as does the invention (see *In re Gordon*, 221 USPQ 1125, 1127 (Fed Cir 1984)), nor even envision that the invention is possible (see *In re Luvisi*, 144 USPQ 646, 650 (CCPA 1965)).

Specifically with respect to claim 1, not only do the references not even contemplate doing anything after limitation c), they specifically do not contemplate limitation d). There is not even the use of the word “art” in any of the references (except for a reference to “those skill in the art” in one, clearly not “art” as used in the instant application), or anything similar to it.

Specifically with respect to claim 20, not only is there no use of “art” in the references, there is no use of the word “black” in either Jam or Ishizuka. Kohno uses that word only twice simply to say that one of its cartridges may use black ink<sup>1</sup>, and there is no discussion of “near black” whatsoever. None of the references have even the most

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<sup>1</sup> “The head cartridge 200 in this example is to hold four ejection portions in total, each of which corresponds to monochrome ink (black, for example) or color ink (cyan, magenta and yellow)...” and “Here, the monochromatic mode performs printing by using only one major color such as black. The multi-color mode carries out printing by using different color inks, and the full-color mode performs printing by color mixing.”

remote suggestion of eliminating 80-100% of black and near black (see *In re Luvisi, supra*), nor do they even contemplate limitation d) of claim 20.

Specifically with respect to claim 24, the references not only do not even remotely contemplate a step after limitation c), they nowhere relate to “teaching”, “children”, “art”, “artistic elements” or “manually acting upon the substrate”.

The dependent claims even more clearly distinguish from the art. For example, there is no disclosure even contemplated in any of the references of manually applying colored paints to spaced portions of a substrate as recited in claim 5; manually applying texture to the substrate as recited in claim 6; adding illustrated objects, etc., to the substrate as recited in claim 23; necessarily only partially disabling one or more colors as recited in claim 8; disabling black and near black as recited in claim 9; using a thermal ink jet printer as recited in claim 10 (note that neither Jam nor Ishizuka even use the word “jet”, and the mere concept of using a printer does not include all specific printers – see *In re Luvisi, supra*); removing a black ink jet cartridge as recited in claim 11 (there is nowhere in Kohno there is a suggestion to remove the black cartridge and continue printing); manually acting on a printed digital photo image as recited in claim 12; producing pseudo-abstract art as recited in claims 13 & 15; disabling black and near black as recited in claims 14 and 25; using the method in an art curriculum to teach art to children as recited in claim 16; manually adding acrylic paint as recited in claim 21; or using at least thirty pound matte paper as the substrate (none of the references even teach matte paper, nor is that important to any aspect of the references since they don’t do anything to a substrate except apply toner/ink) as recited in claim 22.

Not only are all of the features of the claimed invention set forth above not shown by the references even if combined, there is no *prima facie* case of obviousness. When a claim is evaluated under 35 USC §103 the significant inquiry is whether the subject matter as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Graham v John Deere*, 383 US 1, 14 (1956), *In re Dembiczak*, 175 F.3d 994, 999 (Fed Cir 1999). The burden is on the PTO to provide the factual basis for obviousness, not on an applicant to prove non-obviousness. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-8 (CCPA 1967). Here the Action does not provide that

factual basis. And as *In re Pye, supra*, *In re Gordon, supra*, and *In re Luvisi, supra*, make clear, the fact that the references<sup>2</sup> are not concerned with the same proximate problem as the invention, do not achieve the advantageous artwork according to the invention, and do not even suggest specific critical elements of the invention, clearly indicate no obviousness.

Thus it is believed that the application is in clear condition for allowance. Therefore early passage of all of the claims to issue is earnestly solicited.

Respectfully Submitted,



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<sup>2</sup> Please note that the mere fact that Jam and Ishizuka are assumed to be prior art for the purposes of this amendment is NOT an admission that they are prior art.